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BY E-FILING

The Honorable Mary Pat Thyng
United States District Court for the District of Delaware
844 North King Street
Wilmington, DE 19801

PUBLIC VERSION

Re: Honeywell Int'l Inc. v. Apple Computer, Inc., C.A. No. 04-1338-*** (Cons.)

Dear Magistrate Judge Thyng:

We write on behalf of the Plaintiffs ("Honeywell") to seek an order compelling Hitachi Displays, Ltd. ("Hitachi") to produce certain 30(b)(6) witnesses for further deposition time. We also seek a judicial declaration that *res judicata* shall not apply to modules for which Hitachi has refused to provide discovery, or in the alternative, that Hitachi provide the information necessary to accuse such modules of infringement. These issues are scheduled to be heard by the Court on May 17, 2007.

I. Honeywell Seeks an Order Compelling Hitachi to Produce Witnesses for Follow-Up Rule 30(b)(6) Testimony.

In the fall of 2006, Hitachi consented to three deposition dates in January 2007 for the depositions of its designees on various 30(b)(6) topics. Ex. 23. Then, in December 2006, Hitachi notified Honeywell that it would be producing *three* separate Japanese-speaking witnesses to testify about all non-technical issues on *one* day, and noted that there might not be enough time to conduct all three depositions in that one day (an average of two hours and 20 minutes per witness, roughly halved again because of translation). Exs. 1-2. Honeywell proposed that Hitachi make its witnesses available on a scheduled "down day" as well. Hitachi refused. Exs. 2, 4. Honeywell suggested additional alternatives that included every week from January 2007 through early February, offering the United States Embassy and Consulate in Japan and other locations in the United States. Ex. 3. Hitachi refused, suggesting two unacceptable alternatives: that Honeywell delay its depositions until *after* the then-pending deadline for submission of expert reports (February 28, 2007), or that Honeywell cut short its technical deposition on January 24. Both were unacceptable. Ex. 5, p. 2; Ex. 6.

The limited availability for Hitachi's witnesses presented Honeywell with a conundrum: either take the single day offered or further delay the onset of depositions. Given the difficulty in arranging the depositions (and limited Embassy time), Honeywell had no practical choice but to

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go forward and reserve its right to seek additional time with the 30(b)(6) witnesses. Honeywell made its best efforts to conduct the depositions efficiently despite the time limit. Not surprisingly, Honeywell did not have enough time to explore the witnesses' designated topics. Ex. 7, p. 7. Despite repeated requests, Hitachi refused to provide these witnesses for any additional testimony time on selected topics. Ex. 8, p. 4; Ex. 9, p. 2; Ex. 10, p. 3; Exs. 11-13. Hitachi has argued that because Honeywell proceeded despite Hitachi's warnings about the limited schedule, Honeywell should now be foreclosed from further testimony; this of course would reward Hitachi for limiting its witnesses' availability in the first instance.

Despite its refusal to provide follow-up testimony with these three witnesses, Hitachi has agreed to produce a witness later this summer in response to a separate 30(b)(6) notice of deposition in Tokyo, where all of Hitachi's previously-designated witnesses are also located. To that end, counsel for both parties will be in Japan the week of July 2, 2007. Ex. 17. Honeywell has arranged time at the United States Embassy and is arranging the logistics for this deposition, and believes it makes the most sense and is most efficient - for both parties - to complete the earlier depositions at the same time. Given this, it is reasonable for the Court to require Hitachi to make its other witnesses available for follow-up testimony. Honeywell therefore requests that the Court order Hitachi to produce the three witnesses for two additional days of follow-up testimony on the following topics that Honeywell was not able to fully probe due to the limited deposition time: Topic Nos. 2, 5, 6, 11, 12, 14-17, 19.¹

II. Honeywell Seeks a Judicial Declaration that *Res Judicata* Shall Not Apply to Modules For Which Hitachi Refuses to Provide Discovery.

Hitachi flooded Honeywell with approximately 450,000 pages of documents which do not necessarily relate to the specific modules accused of infringement, and is using them to place Honeywell in a "Catch 22" situation. Hitachi's circular logic is as follows: on one hand, Hitachi purports to place "all potentially relevant" modules at issue, and has demanded that Honeywell identify which modules infringe. On the other hand, Hitachi refuses to provide information that would allow Honeywell to identify which modules infringe, because the sizeable production is not correlated with any corresponding modules. Ex. 18.

As the Court is aware, Judge Jordan circumscribed discovery to only those modules accused of infringement. In regard to *res judicata*, Judge Jordan stated that if a defendant does not tell Honeywell "about a different product, nobody I think in their right mind is going to say, well, you gave up a claim against that accused product because you never had the chance to accuse it." Ex. 20 (July 21, 2006 Hearing Transcript at 19). This commentary recognized Honeywell's concern that infringing modules had to be either part of this litigation, or subject to further litigation. Instead of following Judge Jordan's plan, Hitachi produced information for what it viewed as "all potentially relevant modules." The problem with this production is that Hitachi has not disclosed which documents correspond with which modules; therefore, this does

¹ Moreover, the Scheduling Order provides for 50 hours of part-specific deposition time. Hitachi has provided less than half that amount.

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not give Honeywell the "chance to accuse" additional modules.

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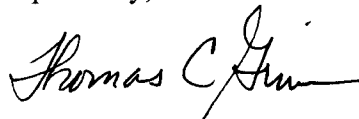
Hitachi has also not provided Rule 33(d) guidance sufficient to identify which modules are disclosed in its sizeable production - REDACTED

As a result of extensive meet-and-confer efforts, Hitachi acknowledged that Honeywell cannot accuse additional modules given the state of Hitachi's production, and has now agreed to associate a few technical diagrams for each module, but only for those sold directly into the United States. Exs. 14-17. While this is a potentially acceptable resolution as far as those modules are concerned (assuming it is done in a timely and complete fashion), it does not resolve the issue of modules that make it into the United States indirectly. Exs. 16, 19.

Honeywell asked Hitachi to confirm that, at least for the modules for which it refuses to provide information appropriately correlating the produced technical documentation to specific modules, *res judicata* shall not apply. Hitachi inexplicably refused. Exs. 16, 19. Thus, Hitachi seeks to place Honeywell between the proverbial rock and a hard place: it will not provide information necessary for Honeywell to accuse modules that are sold worldwide, but wants to argue that Honeywell had the chance to accuse them sufficient to trigger *res judicata*.

Given the size and condition of Hitachi's production, Honeywell requests a judicial declaration that *res judicata* shall not apply to any module for which Hitachi refuses to provide proper identification and correlation with technical documentation (either via Rule 33(d) or a supplemental, correlated production). In the alternative, Honeywell requests that the Court compel Hitachi to provide such identification and correlation for all of its potentially relevant modules that are included in its production.

Respectfully,



Thomas C. Grimm (#1098)

Enclosures

cc: Dr. Peter T. Dalleo, Clerk (by hand, w/encls.)

See attached Certificate of Service

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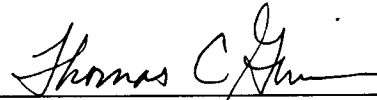
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